

REMARKS/ARGUMENTS

"The examiner should never regard [a complete] reversal [by the Board of Patent Appeals and Interferences] as a challenge to make a new search to uncover other and better references. This is particularly so where the application . . . has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search." M.P.E.P. § 1214.04. Further, "[p]rior art rejections should ordinarily be confined strictly to the best available art. . . . Merely cumulative references, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided." M.P.E.P. § 706.02(I).

In the present case, Examiner Michael A. Delgado entered a final rejection of all claims on April 13, 2004. Applicant appealed the rejection and, on July 31, 2007, the Board entered an opinion reversing all of Examiner Delgado's rejections. On August 27, 2007, barely one month after the Board's decision, Examiner Scott B Christensen has now rejected all of the claims of the application based on three references, two of which were not previously cited against Applicant. Thus, acting contrary to the Patent Office's guidelines (e.g., M.P.E.P. § 1214), Examiner Christensen clearly took the Board's reversal as a challenge to make a new search for other references to rely on as a basis for rejecting the claims of the present application.

Examiner Christensen even rejected claims 1-8 under 35 U.S.C. § 102(e) based on U.S. Patent No. 5,974,122 to *Nelson*, and claims 9-19 under 35 U.S.C. § 103(a) based on *Nelson* and an Internet reference allegedly posted on February 29, 2000. These rejections are astounding because the Board, in it's July 31, 2007 decision, has already reversed a rejection of these claims under 35 U.S.C. § 103(a) over *Nelson* in combination with other references. Applicant reminds the Examiner that the proper method for challenging a Board decision in accordance with

M.P.E.P. § 1214.04 is to get the approval of the Technology Center Director and the Deputy Commissioner for Patent Examination Policy to request a rehearing of the Board decision. Applicant also believes that, if appealed, these current rejections would be summarily dismissed by the Board as already argued and reversed.

That being said, and even though Applicant disputes the propriety of the latest rejections, a complete response is submitted herewith.

* * *

Claims 1, 3-5, 7-9, 11-13 and 15-19 remain pending in this application. By the amendment submitted herewith, independent claim 1 has been amended to include the limitations of dependent claim 2 and independent claim 9 has been amended to include the limitations of dependent claim 10. Accordingly, claims 2 and 10 have been cancelled and claims 3 and 11 have been amended to correct their dependencies. Claims 6 and 14 are cancelled herein to eliminate redundant claims due to the rewriting just described. Claims 1 and 9 are also amended to clarify aspects of the invention as discussed below with respect to the claim rejections under 35 U.S.C. § 112. Applicant believes that these amendments do not add new matter to the application. In view of the claim amendments herein, Applicant submits that all rejections should be withdrawn and that all claims of the application are in condition for allowance.

I. Drawing Objection

Fig. 2 was objected to as including reference character 36 which was not mentioned in the description. The paragraph beginning at page 7, line 20 has been amended to include reference to step 36, shown in Fig. 2. This amendment is supported by Fig. 2 of the application

as filed, and thus no new matter is added by this amendment. Applicant submits that the drawing objection should now be withdrawn.

II. Specification Objections and Amendments

The phrase "or yet to be developed protocols" at page 5, lines 4-5 and page 5, line 22 was objected to as not being subject matter possessed by the Applicant at the time of filing. Applicant has deleted the phrase from the application and thus submits that these objections should now be withdrawn.

The paragraph beginning at page 5, line 1 has been amended to correct typographical errors by changing "INAP4" to "IMAP4" and "use" to "user". The paragraph beginning at page 5, line 19 has also been amended to correct a typographical error by changing "INAP4" to "IMAP4". The paragraph beginning at page 7, line 20 has been amended to correct typographical errors by changing "relay server 14" to "relay server 16" as shown in Fig. 1 and inserting the word "the" in the phrase "re-route the message". Additionally, the paragraph beginning at page 12, line 7 has been amended by changing "Intranet" to "intranet" and by changing "intranet servers 66" to "Internet servers 66" as shown in Fig. 3. Applicant submits that these specification amendments do not add new matter to the application because they are typographical in nature and supported by the application as filed.

III. Claim Rejections Under 35 U.S.C. § 112

Claims 1-2 and 9 were rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended claims 1 and 9 to clarify aspects of the invention and claim 2 is cancelled. Therefore, Applicant submits that these rejections should be withdrawn.

In accordance with the examiner's suggestion, the phrase "when the message is undeliverable to the messaging server" at claim 1, step (b) has been amended to "when the messaging server is inoperable such that the message is undeliverable to the messaging server." This amendment is supported by the original application at page 6, lines 24-25. Therefore, Applicant submits that no new matter is added by this amendment.

In claim 1, step (c), the phrase "re-routing the message from the relay server to the messaging server when operational" has been amended to "re-routing the message from the relay server to the messaging server if the messaging server becomes operational." This amendment is supported by the original application at page 7, lines 5-19. Therefore, Applicant submits that no new matter is added by this amendment. The amendment clarifies that the message is re-routed from the relay server to the messaging server **if** the messaging server becomes operational and not **when** the messaging server becomes operational. It is not a limitation of the claim that the messaging server become operational. If the messaging server does not become operational, then step (d) of claim 1 as amended applies.

Step (d) of claim 2 has been added to claim 1 and claim 2 has been cancelled. Step (d) has also been amended from "invoking another messaging server when the message is undeliverable to the messaging server in step (c)" to "invoking another messaging server if the messaging server in step (c) does not become operational". This amendment is supported by the original application at page 7, lines 20-27. Therefore, Applicant submits that no new matter is added by this amendment. The amendment to step (d) clarifies that invoking another messaging server is an alternative to re-routing the message to the original messaging server as in step (c). If the messaging server of step (c) becomes operational, then the message is re-routed from the relay server to the messaging server. If the messaging server of step (c) does not become

operational, then another messaging server is invoked as recited in step (d). Applicant submits that the amendments to claim 1 obviate the rejections under 35 U.S.C. § 112, and thus the rejections should be withdrawn.

Claim 9 was rejected under 35 U.S.C. § 112 because it was unclear what "when operational" referred to. The claim has been amended so it is clear that "the relay server is operable to re-route the message from the relay server to the messaging server if the messaging server becomes operational." This amendment is supported by the original application at page 6, lines 24-25. Therefore, Applicant submits that no new matter is added by this amendment and that the rejection of claim 9 under 35 U.S.C. § 112 should be withdrawn.

IV. Claim Rejections Under 35 U.S.C. § 102 and § 103

Claims 1-8 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,974,122 to Nelson ("Nelson") and claims 9-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of "DNS (domain name system)" allegedly posted on the Internet on February 29, 2000. Claims 1-16 are rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,859,821 to Ozzie ("Ozzie") and claims 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ozzie. Claims 1-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2001/0036822 to Mead ("Mead"). In response to these rejections, Claim 1 has been amended to include the limitations of claim 2, and claim 9 has been amended to include the limitations of claim 10. For the reasons discussed below, Applicant submits that the rejections of independent claims 1 and 9, and dependent claims 3-5, 7-8, 11-13 and 15-19, should be withdrawn.

A. Claims 1, 3-5 & 7-8

Independent claim 1 has been amended to include the limitations of claim 2 and claim 2 has been cancelled. Both claims 1 and 2 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nelson, Ozzie and Mead. The deficiencies in the Examiner's rejections are discussed below with respect to each of the three references.

Claim 1 as amended requires, *inter alia*: A method for providing a messaging service on a computer network, comprising: (a) routing a message to a messaging server; (b) providing the message to a relay server when the messaging server is inoperable; (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and (d) invoking another messaging server if the messaging server in step (c) does not become operational.

1. Nelson

Nelson discloses a system and method for delivery of a facsimile to an intended destination when that destination is initially unavailable. In the system of Nelson, a facsimile message transmission is first attempted by initiating a telephone call from a first fax machine to an intended destination second fax machine. If the second fax machine is available and answers the telephone call, the facsimile message is transmitted to the second fax machine. However, if the second fax machine is not available (*i.e.*, busy or no answer), the facsimile message is routed to, and stored on, a messaging platform. The messaging platform, according to a predetermined schedule, makes subsequent calls to the second fax machine. If the second fax machine answers, the facsimile message is delivered from the messaging system to the second fax machine. If the second fax machine is busy or does not answer, the messaging platform stores the message and re-attempts delivery at a later time according to the predetermined schedule. If transmission of

the facsimile message to the second fax machine is still unsuccessful after several re-attempts, a message is sent back to the originator of the facsimile message, informing them that delivery could not be accomplished.

Nelson does not disclose: (1) A method for providing a messaging service on a **computer network** . . . comprising . . . routing a message to a **messaging server**; or (2) invoking **another messaging server** if the messaging server in step (c) does not become operational. Regarding limitation (1), as discussed above Nelson discloses a method for delivering facsimile messages over telephone lines, not a method for providing a messaging service on a **computer network**. Transmitting facsimile messages between fax machines is different than transmitting messages to a messaging server that is part of a computer network. Even the Examiner states that "[t]he fax machines . . . are interpreted as being similar to messaging servers". It is improper to reject a claim under 35 U.S.C. § 102(e) unless the cited reference discloses all limitations of the claim at issue. Mere similarity between the fax machines described in Nelson and the claimed computer messaging server is not enough to support the Examiner's 35 U.S.C. § 102(e) rejection.

Nelson also does not disclose limitation (2) above, namely, invoking **another messaging server** if the messaging server in step (c) does not become operational. As discussed above, Nelson discloses a system and method for delivery of a facsimile to an intended destination by storing and repeatedly re-attempting transmission of the facsimile to the destination. In Nelson, however, if a destination is busy or does not answer, an Analyze Route Message is returned to the originating number, indicating that the intended destination was not available (*see* Nelson, column 5, lines 30-41). Thus, Nelson does not disclose invoking another messaging server to allow delivery of the message when the original messaging server does not become operational.

The Examiner states that Fax Messaging Platform 134, shown in Fig. 2 of Nelson, "is interpreted as being another messaging server, as it provides the message to other devices or programs." The Examiner also maintains that Fax Messaging Platform 134 operates as the claimed "relay server". Clearly, Fax Messaging Platform 134 cannot serve as both the "relay server" and the "another messaging server" of claim 1. Nelson does not disclose Fax Messaging Server 134 acting as the "relay server" and delivering a message to itself as the "another messaging server" if the original fax recipient does not become operational. It does not make sense for the Fax Messaging Platform 134 to deliver a message to itself. If the facsimile transmission of Nelson is undeliverable to its intended recipient, than the facsimile is not transmitted and the sender is notified via the Analyze Route Message described above.

For the reasons above, Applicant submits that the Examiner should withdraw the rejection of claim 1 in light of Nelson. The Applicant also submits that the rejection of claims 3-5 and 7-8 should be withdrawn because the claims are dependent from an allowable independent claim.

2. Ozzie

Ozzie discloses a method and apparatus for prioritizing data change requests and maintaining data consistency in a computer network. In the system of Ozzie, a plurality of peer units are equipped for communication via the Internet. Each peer unit has a communications manager that is connected to the Internet and controls communication between peer units. The Internet has a presence server which detects whether peer units are on-line or off-line and a relay with the capability to store messages destined for off-line peer units. If a peer unit sends a message to another peer unit and the other peer unit is on-line, then the message is delivered directly to the other peer unit. If the destination peer unit is off-line when the message is sent,

then the message is delivered to the relay which stores the message until the destination peer unit returns on-line. However, if the destination peer unit does not return on-line, then the message is not delivered.

Ozzie does not disclose "invoking **another messaging server** if the messaging server in step (c) does not become operational." As discussed above, Ozzie discloses a network of peer units which communicate via the internet. If a peer unit sends a message and the destination peer unit is not available for receiving a message, then the message is sent to a relay. The relay stores the message and delivers it to the destination peer unit when it becomes available. If the destination peer unit does not become available, then the message is not delivered. Thus, Ozzie does not disclose invoking another messaging server if the destination messaging server does not become operational.

The Examiner states that step (d) is never performed because step (c) is only performed when the messaging server is operational and step (d) is only performed when the message is undeliverable to the messaging server in step (c). The amendments to claim 1, discussed above with respect to the § 112 rejections, clarify that the re-routing in step (c) is performed *if* the messaging server becomes operational and the invoking in step (d) is performed *if* the messaging server in step (c) does not become operational. The Examiner further states that "the relay server, which is equivalent to another messaging server, is invoked when the message is undeliverable to the messaging server." As discussed above with respect to Nelson, the relay in Ozzie can not anticipate both the claimed "relay server" and the "another messaging server" because Ozzie does not disclose the relay sending a message to itself if a destination peer unit does not become on-line.

For the reasons above, Applicant submits that the Examiner should withdraw the rejection of claim 1 in light of Ozzie. The Applicant also submits that the rejection of claims 3-5 and 7-8 should be withdrawn because the claims are dependent from an allowable independent claim.

3. Mead

Mead discloses a system for delivering electronic mail between users in a vehicle and users outside a vehicle. In the system of Mead, a message can be sent from a home mail server to a vehicle server via an intermediate ground server. The ground server communicates with the home mail server via a network (e.g. the Internet), and the ground server communicates with the vehicle server via a data link. The vehicle server is located on a vehicle and allows users on the vehicle to send messages through their home mail server and receive messages from their home mail server. The vehicle server and ground server are not necessarily in constant communication, but instead decide when to connect based on factors such as the amount of data to be transmitted, the urgency of the data, geographic location and data type.

Mead does not disclose "(b) providing the message to a relay server when the messaging server is inoperable . . . ; (c) re-routing the message from the relay server to the messaging server if the messaging server becomes operational; and (d) invoking another messaging server if the messaging server in step (c) does not become operational".

As discussed above Mead discloses sending a message from a home mail server to a vehicle server via an intermediate ground server. Mead does not disclose any of the servers becoming inoperable and Mead does not disclose where a message would be sent if any of the servers became inoperable. Therefore, Mead does not disclose providing a message to a relay server when the messaging server is inoperable, re-routing the message from the relay server to

the messaging server if the messaging server becomes operational, and invoking another messaging server if the messaging server in step (c) becomes operational.

Regarding step (b), the Examiner states that it only needs to be performed when the message is undeliverable and that there is no requirement that the message be undeliverable. Claim 1 as amended requires "invoking another messaging server if the messaging server in step (c) does not become operational". This limitation is a requirement that must occur if the message is undeliverable and Mead does not disclose this limitation.

The Examiner states that step (c) is only performed if step (b) occurred because the relay server only has the message if the message was undeliverable to the messaging server. The Examiner is correct that step (c) is only performed if step (b) occurred. However, Mead still does not disclose step (c), because Mead does not disclose what happens if a server becomes inoperable.

Regarding step (d), the Examiner states that when the servers of Mead are all available the method as claimed is clearly performed because step (d) only needs to occur when the messaging server is unavailable in step (b). However, Mead does not disclose what happens when its servers are **inoperable**. Mead does not disclose providing a message to a relay server when the messaging server is inoperable, re-routing the message from the relay server to a messaging server if the messaging server becomes operational and invoking another messaging server if the messaging server in step (c) does not become operational.

For the reasons above, Applicant submits that the Examiner should withdraw the rejection of claim 1 in light of Mead. The Applicant also submits that the rejection of claims 3-5 and 7-8 should be withdrawn because the claims are dependent from an allowable independent claim.

B. Claims 9, 11-13 & 15-19

Independent claim 9 has been amended to include the limitations of claim 10 and claim 10 has been cancelled. Both claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson in view of "DNS (domain name system)", and under 35 U.S.C. § 102(e) as being anticipated by Ozzie and Mead. The deficiencies in the Examiner's rejections are discussed below with respect to each of the references.

Claim 9 as amended requires, *inter alia*:

A computer network for providing a messaging service comprising:
a messaging server;
a DNS server operable to route a message to the messaging server;
a relay server operably connected to the DNS server and the messaging server, the DNS server operable to provide the message to the relay server when the messaging server is inoperable . . . ;
wherein the relay server is operable to re-route the message from the relay server to the messaging server if the messaging server becomes operational; and
another messaging server, the other messaging server invoked by the relay server if the messaging server does not become operable

1. Nelson and DNS (domain name system)

First, Applicant disputes that the "DNS (domain name system)" reference was available as of February 29, 2000. The Examiner cites an Internet website named the "Wayback Machine" as evidence that the reference was available on February 29, 2000. However, the actual website the Examiner seeks to use as a reference lists a publication date of February 16, 2004 (Whatis.com, What is domain name system? – a definition from Whatis.com, http://searchnetworking.techtarget.com/sDefinition/0,,sid7_gci213908,00.html (last visited Oct. 4, 2007)). Applicant traverses the Examiner's use of the "Wayback Machine" as evidence that this reference was available on February 29, 2000, and therefore submits that the rejection of claims 9, 11-13 and 15-19 should be withdrawn.

Assuming arguendo that the Examiner's citation to the "Wayback Machine" was proper, the rejection of claims 9, 11-13 and 15-19 based on Nelson and DNS (domain name system) should be withdrawn for the reasons presented below.

As discussed above with respect to Claim 1, Nelson does not disclose (1) a **computer network** for providing a **messaging service**; or (2) **another messaging server** which is invoked by the relay server if the messaging server does not become operable. Regarding limitation (1), Nelson instead discloses a facsimile transmission system which is different from a computer network for providing a messaging service. Regarding limitation (2), if the fax recipient in Nelson is inoperable, the system sends an Analyze Route Message back to the originating fax machine. There is no disclosure of another fax machine which is invoked by the fax messaging platform. Further, the reference DNS (domain name server) does not disclose these limitations. For these reasons and any of the reasons discussed above with respect to claim 1, Applicant submits that claim 9 is allowable and the rejection under 35 U.S.C. § 103(a) should be withdrawn. Applicant also submits that the rejection of claims 11-13 and 15-19 should be withdrawn because the claims are dependent from an allowable independent claim.

2. Ozzie

As discussed above with respect to claim 1, Ozzie does not disclose "**another messaging server**, the other messaging server invoked by the relay server if the messaging server does not become operable". A message stored in the relay of Ozzie is not delivered if the destination peer unit does not become operable. For this reason and the reasons discussed above with respect to claim 1, Applicant submits that claim 9 is allowable and the rejection under 35 U.S.C. § 102(e) should be withdrawn. Applicant also submits that the rejection of claims 11-13 and 15-19 should be withdrawn because the claims are dependent from an allowable independent claim.

3. Mead

As discussed above with respect to claim 1, Mead neither discloses any of its servers becoming inoperable nor the path a message would take if any of its servers became inoperable. Mead merely discloses sending a message from a home mail server to a vehicle server via an intermediate ground server. Therefore, Mead does not anticipate the limitations of claim 9. For these reasons and the reasons discussed above with respect to claim 1, Applicant submits that claim 9 is allowable and the rejection under 35 U.S.C. § 102(e) should be withdrawn. Applicant also submits that the rejection of claims 11-13 and 15-19 should be withdrawn because the claims are dependent from an allowable independent claim.

In view of the foregoing amendments and remarks it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below.

Acknowledgement of receipt is respectfully requested.

Respectfully submitted,

By:



Mark C. Young, Reg. No. 48,670
STINSON MORRISON HECKER LLP
1201 Walnut, Suite 2900
Kansas City, MO 64106-2150
Telephone: (816) 842-8600
Facsimile: (816) 691-3495